Tay Siew Kiat (t/a Chop Soon Loong) v Wan Leong Chai (t/a Thye Guan Hing)

HIGH COURT (KUALA LUMPUR) — SUIT NO D1–22–2228 OF 2000
VINCENT NG J
8 APRIL 2004

Civil Procedure — Contempt of court — Breach of consent order — Application to cite the defendant for contempt of court — Which test to apply — Whether 'unerring judge's eye or instructed eye test' or 'beyond reasonable doubt test'

The plaintiff had filed a writ action against the defendant praying for, inter alia, injunction, discovery, damages and costs for infringing, attempt to infringe, passing off or attempt to pass off the industrial design of a table cloth registered in favour of the plaintiff. The plaintiff's claim was vigorously resisted by the defendant on the grounds, inter alia, that the design, pattern and number of curves of the defendant's table cloth was different from plaintiff's registered industrial design. Nevertheless, as an interim measure, an interim injunction order was entered into by consent of both parties on 13 June 2001 ('the consent order'). The plaintiff's application now was to cite the defendant for contempt of court for having breached the consent order. The plaintiff's case was that the table cloths offered for sale by the defendant after service of the consent order and the said registered industrial design was so similar in shape and configuration or pattern that they were likely to confuse and therefore the defendant had committed an act of infringement and thereby breached the consent order. The plaintiff's allegation was forcefully denied by the defendant, who averred that the consent order was recorded merely to maintain the status quo of the case pending the hearing of his own application to set aside the plaintiff's registration of the industrial design of the table cloth.

Held, dismissing the application:

(1) The High Court's current focus in the contempt proceedings should not be the 'unerring judge's eye' or 'instructed eye' test on comparison of designs, configuration or pattern as a whole or in separate parts, but rather the 'beyond reasonable doubt test' to determine whether a contempt had been committed (see para 19).

(2) To commit a person to prison for contempt, the terms and nature of the injunction, allegedly willfully disobeyed, must be construed narrowly and must necessarily be quite unambiguous and unequivocal. Mindful also, that as it was an offence of a criminal character, the breach of the terms of the order must be proved beyond reasonable doubt (see para 21).

(3) In such contempt proceedings, it is incumbent upon the High Court to embark upon a three-step approach. Firstly, to examine critically, with a fine toothcomb, the precise nature and ambit of the order made. Secondly, to ask whether there was a contemptuous or contumelious breach of order. And, thirdly, whether the breach occurred after the alleged contemptnor was served with the order, which order must essentially bear the penalty endorsement (see para 22).

(4) The crux of the problem before the court in this contempt proceedings was that the precise nature and getup of the two impugned table cloths allegedly sold by the defendant, was not exhibited or appended in the consent order. Thus, exhibiting the table cloths in the affidavit supporting the application was insufficient as, in a charge for criminal contempt, it was the very court order rather than the cause papers that the court should have exclusive reference to. Consequently, the High Court was left in the dark as to the precise nature of the alleged breach by the defendant upon which the contempt proceedings was founded (see para 25).

[**Bahasa Malaysia summary**

Plaintif telah memfailkan satu writ tindakan terhadap defendan memohon untuk, antara lain, injunksi, penemuan, ganti rugi dan kos kerana melanggar, percubaan untuk melanggar, kelirupaan atau percubaan untuk mengelirupakan rekaan perusahaan sehelai alas meja yang didaftarkan bagi pihak plaintif. Tuntutan plaintif dengan keras dibantah oleh defendan atas alasan, antara lain, bahawa rekaan, corak dan bilangan lekok pada alas meja defendan berbeza dengan rekaan perusahaan berdaftar plaintif. Namun begitu, sebagai langkah sementara, satu perintah injunksi interim telah dimasukkan dengan persetujuan kedua pihak pada 13 Jun 2001 ('perintah persetujuan tersebut'). Permohonan plaintif sekarang adalah untuk menyaman defendan untuk penghinaan mahkamah kerana melanggar perintah persetujuan tersebut. Kes plaintif adalah bahawa alas-alas meja tersebut telah ditawarkan untuk jualan oleh defendan selepas penyampaian perintah persetujuan tersebut dan rekaan perusahaan yang didaftarkan tersebut adalah sama dalam bentuk dan tatarajah atau corak yang mungkin telah mengelirukan mereka dan oleh itu defendan telah melakukan satu tindakan yang melanggar dan dengan itu melanggar perintah persetujuan tersebut. Pengataan plaintif dengan tegas telah dinafikan oleh defendan, yang menegaskan bahawa perintah persetujuan tersebut telah direkodkan hanya untuk mengekalkan status quo kes sementara menunggu perbicaraan permohonan beliau untuk mengenepikan pendaftaran rekaan perusahaan alas meja plaintif.

Diputuskan, menolak eprmohonan tersebut:

(1) Fokus semasa Mahkamah Tinggi dalam prosiding penghinaan tidak sepatutnya merupakan ujian 'unerring judge's eye' atau 'instructed eye' berhubung perbandingan rekaan, dan tatarajah atau corak secara keseluruhan atau bahagian-bahagian berasingan, tetapi lebih kepada 'beyond reasonable doubt test' untuk menentukan sama ada satu penghinaan telah dilakukan (lihat perenggan 19).

(2) Untuk memenjarakan seseorang kerana penghinaan, terma-terma dan sifat injunksi tersebut, yang dikatakan tidak patuh dengan sengaja, harus ditafsir secara terperinci dan perlulah tidak taksa dan jelas. Perlulah diambilkira juga, bahawa memandangkan ia satu kesalahan bersifat jenayah, perlanggaran terma-terma perintah tersebut hendaklah dibuktikan melampaui keraguan munasabah (lihat perenggan 21).

(3) Dalam prosiding penghinaan sebegini, adalah menjadi kewajipan Mahkamah Tinggi untuk menggunakan satu pendekatan tiga langkah. Pertama, untuk memeriksa secara kritikal, dengan teliti, sifat dan lingkungan terperinci perintah tersebut dibuat. Kedua, untuk bertanyakan sama ada terdapat satu perlanggaran yang menghina atau tidak mengendahkan perintah tersebut. Dan ketiga, sama ada perlanggaran tersebut berlaku selepat peghina yang dikatakan tersebut telah diserahkan perintah tersebut, yang mana perintah tersebut perlu ada pengindorsan penalti tersebut (lihat perenggan 22).

(4) Inti pati masalah di hadapan mahkamah dalam prosiding penghinaan tersebut adalah bahawa sifat dan hiasan terperinci dua alas meja yang dipersoalkan yang dikatakan telah dijual oleh defendan, tidak diekshibit atau dilampirkan dalam perintah persetujuan tersebut. Oleh itu, dengan mengekshibitkan alas-alas meja tersebut dalam afidavit yang menyokong permohonan tersebut tidak mencukupi kerana, dalam satu pertuduhan untuk penghinaan berbentuk jenayah, ia adalah perintah mahkamah tersebut dan bukan kertas-kertas kausa yang mahkamah sepatutnya mempunyai rujukan eksklusif. Akibatnya, Mahkamah Tinggi tidak dapat memutuskan tentang sifat terperinci perlanggaran yang dikatakan oleh defendan yang mana prosiding penghinaan tersebut didapati (lihat perenggan 25).]

Notes

For cases on breach of consent order, see 2(3) *Mallal's Digest* (4th Ed, 2001 Reissue) paras 1432–1433.

Cases refered to

Bondor Pty Ltd & Ors v National Panels Pty Ltd [1990] ALR Vol 98 114 (refd)
Bramblevale Ltd, Re [1970] Ch 128 (refd)
Breville Europe v Thorn EMI Domestic Appliances Limited [1995] FSR 77 (refd)
Cow v Cannon [1959] RPC 240 (refd)
Dalgerty Australia Operations Ltd v Seeley (FF) Nominees Pty Ltd [1985] 68 ALR 421 (refd)
Firmagroup Australia Pty Ltd v Byrne & Davidson Doors (Vic) Pty Ltd [1987] 73 ALR 321 (refd)
Hothersall v Moore [1802] RPC Vol IX 27 (refd)
Holdsworth v Mc'Crea [1867] LR 2 HL 380 (refd)
Iberian Trust Ltd and Investment Co Ltd [1932] 2 KB 87 (refd)
Interlego AG v Tyco Industries Inc & Ors [1989] 1 AC 217 (refd)
PA Thomas & Co & Ors v Mould & Ors [1968] 2 QB (refd)
Polygram Records Sdn Bhd & Ors v Phua Tai Eng [1986] 2 MLJ 87 (refd)
Redland Tiles Ltd & Ors v Kua Hong Brick Tile Works [1966] 2 MLJ 62 (refd)
Tiu Shi Kian v Red Rose Restaurant Sdn Bhd [1984] 2 MLJ 313 (refd)
UPL Group Ltd v Dux Engineers Ltd [1989] 3 NZLR 135 (refd)

Legislation referred to

Industrial Design Act 1996 ss 3, 10(1), 12(1), (2)(a)

Edwin Lim (YY Ho with him) (WA Lau & Partners) for the plaintiff.
M Pani (Kim Seng Sinnu & Co) for the defendant.

Vincent Ng J:

Preamble

[1] The plaintiff had filed a writ action (encl 1) against the defendant praying for, inter alia, injunction, discovery, damages and costs for infringing, attempt to infringe, passing off or attempt to pass off the Industrial Design No MY 99-00186 of a table cloth registered in favour of the plaintiff. The plaintiff's claim was vigorously resisted by the defendant on the grounds, inter alia, that the design, pattern and number of curves of the defendant's table cloth is different from plaintiff's registered industrial design (see para 5 of the defence). Nevertheless, as an interim measure, an interim injunction order was entered into by consent of both parties on 13 June 2001 ('the consent order').

[2] This is the plaintiff's application (encl 47), seeking to cite the defendant for contempt of court for having breached the consent order.

[3] On 21 March 2002, at the request of the solicitors for both parties this court recorded that the parties have unreservedly agreed to submit to the court's determination on encl 47 based solely on affidavit evidence.

The consent interim injunction order

[4] The consent order reads:

> … ADALAH DIPERINTAHKAN SECARA PERSETUJUAN bahawa:
>
> 1 Defendan, sama ada oleh pengkhidmat-pengkhidmat atau ejen-ejennya atau mana-mana daripada mereka atau selainnya dengan apa cara jua, disekat oleh injunksi interim daripada mencerobohi pendaftaran reka bentuk perindustrian no: MY 99-00186 iaitu eksibit 'TSK-2' dalam kandungan 2 sehingga tarikh pendengaran pada 19hb Julai 2001. …

[5] The consent order relates to the plaintiff's industrial design of a table cloth registered as No MY 99-00186 and exhibited as 'TSK 2'. It is noteworthy that the consent order was perfected without any variation.

The law on industrial design cases

[6] Albeit, it will only be pertinent later in the proceedings when encl 10 is heard I propose to very briefly set out the law on industrial design cases and the submissions of counsel for both sides to illustrate how far amiss they were on the target in terms of the proper issues. In encl 10, the defendant sought under s 27(a) to revoke the registration of the plaintiff's Industrial Design No MY 99-00186 pursuant to ss 12(1), 12(2)(a) and 10(1) of the Industrial Design Act 1996 ('the IDA') on the grounds that the said design is not a new design and the plaintiff is not the original owner of same. (Incidentally, to obviate a multiplicity of appeals to the Court of Appeal which the parties are wont to do, as with my decision on encl 47, I would later propose that encl 10 be heard together with encl 1 save that the decision on encl 10 shall immediately precede the decision on encl 1.)

[7] Section 3 of the IDA defines industrial design as:

> features of shape, configuration, pattern or ornament applied to an article by industrial process or means, being feature which in the finished article appeal to and are judged by the eye, …

[8] Relying on this provision, the plaintiff submitted that the registration of his industrial design afforded protection not only to the unique shape and or configuration of his table cloth but also the pattern and or the ornament of the cloth.

[9] Counsel for the plaintiff quoted the following extract of Lindley LJ's judgment in *Clarke's Design* at p 1061 in *The Modern Law of Copyright and Design* (2nd Ed) Vol 1 ('*Clarke's Design*'):

> … the design is for the shape of a thing, the distinction is reduced to the difference between the shape of a thing and a thing of that shape. A design applicable to a thing for its shape can only be applied to a thing by making it in that shape. A design for the shape of something is what is meant by s 60 when shape is in question: and a registered design for a shape of a thing is infringed if that thing is made in the shape shown by the registered design.

[10] The *Clarke's Design* further refers to the case of *Cow v Cannon* [1959] RPC 240 which held that the shape of a uniquely designed water bottle was protected by registered design. In the words of the author at p 1268, it reads as follows:

> There is no reason why a proprietor should not claim design right in all aspects of the shape or configuration of his article which he believes could give him a commercial edge over his competitors. In particular, when it comes to suing a competitor for infringement he will be well advised to rely, individually and collectively, upon each of those separate aspects of shape or configuration which appear to have been copied by the competitor.

[11] It was the plaintiff's contention that the definition in s 3 is disjunctive and not conjunctive whereby a design can be registered if one of the elements of shape, configuration, pattern or ornament is satisfied. Thus, the registration of the plaintiff's design protects its unique shape and/or configuration as illustrated in exh 'TSK 2' and its novelty statement. The Court's attention was also drawn to *Interlego AG v Tyco Industries Inc & Ors* [1989] 1 AC 217 where the Privy Council held, inter alia, that:

> In approaching the definition it is always to be borne in mind what is to be registered. It is a shape, configuration or pattern to be applied to a particular specified article and *it is the shape or configuration of the whole article of which there is to be a commercial monopoly.* (Emphasis added.)

[12] In *Redland Tiles Ltd & Ors v Kua Hong Brick Tile Works* [1966] 2 MLJ 62, it was held that:

> The question whether a design which is alleged to infringe a registered design is or is not an infringement must be determined by eye alone. The court has to decide only whether the alleged infringement has the same shape or pattern …

[13] Also in both *UPL Group Ltd v Dux Engineers Ltd* [1989] 3 NZLR 135 and *Breville Europe v Thorn EMI Domestic Appliances Limited* [1995] FSR 77, the court appeared to apply the similar test, that is to say, in assessing the

infringement of design, it must be judged solely by eye, the eye of the customer who is going to purchase the article which has to be used in judging and in making the comparison between the alleged infringing article and the registered design.

[14] The plaintiff's case is that the table cloths offered for sale by the defendant after service of the consent order and the said registered industrial design is so similar in shape and configuration or pattern that they are likely to confuse and therefore the defendant had committed an act of infringement and thereby breached the consent order.

[15] The plaintiff's allegation was forcefully denied by the defendant, who averred that the consent order was recorded merely to maintain the status quo of the case pending the hearing of his own application to set aside the plaintiff's registration of the industrial design of the table cloth as in encl 10. The defendant pointed out that the ambit of the order served only to prohibit him from selling the table cloth identified as exh 'TSK 2' in encl 2 but not from carrying on his business of selling table cloths. *The defendant denied that the table cloths he sold were the same as exh 'TSK 2'.*

[16] The defendant relied upon the judgment of the Australian Federal Court in *Dalgerty Australia Operations Ltd v Seeley (FF) Nominees Pty Ltd* [1985] 68 ALR 421 at p 425 wherein Bollen J approved the test applied by the trial judge to determine whether a particular subject matter is infringing another, namely that:

> *The comparison is a question of fact for the eye to judge but an eye instructed as to the meaning and identity of the registered design and the features which are to be compared …* I must judge by my eye and instructed and assisted by the 'expert witnesses'. (Emphasis added.)

[17] Counsel for the defendant further referred to *Hothersall v Moore* [1802] RPC Vol IX 27 wherein Lord Bristow relied on the judge's eye test of Lord Westbury in *Holdsworth v Mc'Crea* [1867] LR 2 HL 380 and held that:

> … Whether, therefore, there is piracy or not, is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same. … if a design, as exhibited in a pattern, is filed and registered by an inventor, without any further limitation or description than that which is given by the design itself, it protects the entire thing and the entire thing only, and the protection cannot, at pleasure, be made applicable one day to the entirety, and another day to the separate integral parts or elements of the entire design. It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register, and is applicable to nothing but an exact copy of the thing so registered. What appears to be registered, and is de facto and de jure registered, is the entirety of the pattern, and the registration is not capable of being made the subject of ambiguous claims …

[18] And, buttressed the above authorities with words of Pincus J in *Bondor Pty Ltd & Ors v National Panels Pty Ltd* [1990] ALR Vol 98 114 at p 118, who intoned in no uncertain terms that no one has 'a monopoly of what might be described as a category or family of designs, of quite different appearance, which have in common that they may be all reduced to one by appropriate expansions or shrinkings of relative dimensions' (see *Firmagroup Australia Pty Ltd v Byrne & Davidson Doors (Vic) Pty Ltd* [1987] 73 ALR 321).

[19] In my opinion, both counsel were wholly off the mark — barking up the wrong tree — in their submissions as this court's current focus in the contempt proceedings should not be the 'unerring judge's eye' or 'instructed eye test' on comparison of designs, configuration or pattern as a whole or in separate parts, but rather the 'beyond reasonable doubt test' to determine whether a contempt has been committed. (Incidentally, I am of tentative opinion that the words 'that are likely to confuse and mislead' tends to indicate that the registered design and the alleged infringing article both ought to be looked at as a whole and the latter need not be 'an exact copy of the thing so registered'.) Surely, the current complaint logically concerns exclusively, the breach of the consent order rather than the similarity of design of the table cloth, bearing in mind that the acute similarity of the designs, configuration or pattern of the plaintiff's and defendant's table cloths has, at all material times been acutely disputed, which indeed necessitated this court's eventual adjudication on encl 1. Thus, I shall now proceed to briefly discuss the law on contempt proceedings.

The law on contempt proceedings

[20] The law on contempt proceedings in civil cases is well settled (see *Tiu Shi Kian v Red Rose Restaurant Sdn Bhd* [1984] 2 MLJ 313).

[21] To commit a person to prison for contempt, the terms and nature of the injunction, allegedly willfully disobeyed, must be construed narrowly (see *Iberian Trust Ltd and Investment Co Ltd* [1932] 2 KB 87) and must necessarily be quite unambiguous and unequivocal (see *PA Thomas & Co & Ors v Mould & Ors* [1968] 2 QB at p 917). Mindful also, that as it is an offence of a criminal character the breach of the terms of the order must be proved beyond reasonable doubt (see *Re Bramblevale Ltd* [1970] Ch 128 at p 317 where Lord Denning MR had this to say: 'A contempt of court is an offence of a criminal character. A man may be sent to prison for it. It must be satisfactorily proved. To use the time honoured phrase, it must be proved beyond reasonable doubt.' (see also *Polygram Records Sdn Bhd & Ors v Phua Tai Eng* [1986] 2 MLJ 87).

[22] In such contempt proceedings, it is incumbent upon the court to embark upon a three-step approach. Firstly, to examine critically, with a fine toothcomb, the precise nature and ambit of the order made. Secondly, to ask whether there was a contemptuous or contumelious breach of order. And, thirdly, whether the breach occurred after the alleged contemptnor was served with the order, which order must essentially bear the penalty endorsement.

[23] Hence, in the current case, taking the approach as guided by the above two authorities and the three principles laid out by me, it is incumbent upon this court to first consider whether the interim injunction order dated 13 June 2001 entered by consent (the consent order) was couched in unambiguous and clear terms which are sufficient to affix criminal liability on the defendant should he commit breach thereof. It is not disputed that the consent order bearing the penalty endorsement was duly served on the defendant on 4 July 2001.

[24] The consent order only enjoins in the following language: **A**

> The defendant by his employees or his agents or anyone of them in whatever manner be restrained through an interim injunction from passing off of the industrial design registered as No MY 99-00186 as shown in exh 'TSK-2' in encl 2 until the date of the disposal on 19 July 2001 of encl 10.

[25] Under the circumstances, I could, while perhaps indulging in the realm **B** of surmise, speculate that the following scenario may have transpired between the parties shortly before the record of the consent order. The plaintiff accused the defendant of selling, among other goods including various table cloths, two table cloths that bear sufficient similarity in design and getup to the plaintiff's table cloth registered under Industrial Design No MY 99-00186 exhibited as 'TSK 2'. The defendant denied the charge. However, following **C** negotiations the defendant may have agreed, though without any admission as to the alleged infringement, to refrain from selling the two particular table cloths until 19 July 2001, when the application under encl 10 was due to be heard. This may have led to the consent order being entered. Nevertheless, even upon the assumption that the aforesaid scenario transpired, yet the crux of the problem before the court in this contempt proceedings is that **D** the precise nature and getup of the two impugned table cloths allegedly sold by the defendant, was not exhibited or appended in the consent order. Thus, exhibiting the table cloths in the affidavit supporting the application is insufficient as, in a charge for criminal contempt, it is the very court order rather than the cause papers that the court shall have exclusive reference to. **E** Consequently, this court is left in the dark as to the precise nature of the alleged breach by the defendant upon which the contempt proceedings was founded.

[26] This case is easy to decide, though not patently so, as counsel on both sides of the divide has each committed a cardinal error in analytical focus. Whilst the plaintiff's counsel has failed to incorporate in the consent order **F** the precise design and getup of the table cloth that was the subject matter of the consent order — and this is a fatal omission in contempt proceedings — the defendant's counsel did not seek to impugn the content and nature of the consent order vis-à-vis the requirements in contempt proceedings; though no doubt he is precluded from questioning the consensual nature of the order. At this juncture, I may make an observation. It is such a pleasure, **G** no doubt on rare occasions, to read or hear submissions of counsel who are well endowed with, I would term, the 'beautiful mind' (more precisely, the 'beautiful tapestry of an analytical mind') in cutting out or cutting through the chaff and seizing the kernel to lay out the gist in lucid logical sequence.

[27] Thus, applying the above principles on citation for contempt that **H** courts are obliged to follow, this court was unable to find the defendant in contempt of the consent order and dismissed the plaintiff's application in encl 47 with costs.

Application dismissed.

Reported by Sally Kee Seok Meng **I**